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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,189	01/23/2004	Jawahar M. Dcsai	DES1.002US3	7841
36257 7590 08/02/2007 DAVIS WRIGHT TREMAINE LLP 505 MONTGOMERY STREET SUITE 800 SAN FRANCISCO, CA 94111			EXAMINER HALL, DEANNA K	
			ART UNIT 3767	PAPER NUMBER
			NOTIFICATION DATE 08/02/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

10/764,189

Applicant(s)

DESAI, JAWAHAR M.

Examiner

Deanna K. Hall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date January 23, 2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on January 23, 2004 is in compliance with the provisions of 37 CFR 1.97(b). Accordingly, the IDS is being considered by the Examiner.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to **patentability** as defined in 37 CFR 1.56.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's recitation of the passageway in claim 1 is confusing. It is said that the passageway extends "throughout the length of the tube

and forming a wall proximal and distal openings.” Did applicant intent to place the word “with” after the word “wall?”

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kolin (US 3,734,083).** Kolin '083 discloses:

A catheter with wing members 22 and distal openings 36 and 18 and a valve in the form of a plunger which engages at the distal opening of the catheter. Electrodes 26 and 28 as shown in figure 2 inherently act as flow restrictors. The thermosetting plastic provides the means to bias the wings in their expanded state.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 6, 11 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolin '083 in view of Kolin (US 3,757,773).** Kolin '083 shows as

discussed above but does not directly show an external tube that compresses the wings of the tube. Kolin '773, in the analogous art, teaches that guide tubes for positioning and collapsing flow meter catheters were well known in the art, see background.

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Kolin '083 with the guide tube as taught by Kolin '773, in other words, use the guide tube as in Kolin '773 for inserting the catheter of Kolin '083 in order to insert the catheter into the appropriate blood vessel.

9. **Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolin '083 in view of Kanesaka (US 5,381,790).** Kolin '083 shows as discussed above but does not directly show a guidewire sized to have the valve seal about the guidewire. Kanesaka, in the analogous art, teaches a guidewire A16. Guidewires members are conventional for aiding in accessing branch arteries as was well known in the art. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Kolin '083 with the guidewire as taught by Kanesaka to position the Kolin device in the branch arteries. Further, to have used a large diameter guidewire to have valve member opening 42 to be occluded would be obvious to prevent the flow of blood out of the patient during insertion.

10. **Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolin '083 in view of Kolin '773 as applied to claim 11 above and further in view of Kanesaka (US 5,381,790).** The combination of Kolin '083 and Kolin '773

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shows as discussed above but does not directly show a guidewire sized to have the valve seal about the guidewire. Kanesaka, in the analogous art, teaches a guidewire A16. Guidewires members are conventional for aiding in accessing branch arteries as was well known in the art. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Kolin '083/Kolin '773 with the guidewire as taught by Kanesaka to position the Kolin device in the branch arteries. Further, to have used a large diameter guidewire to have valve member opening 42 to be occluded would be obvious to prevent the flow of blood out of the patient during insertion.

### ***Double Patenting***

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 1-3 and 11-14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 9 and 10 of prior U.S. Patent No. 6,052,612. This is a double patenting rejection.

13. Claims 1, 4, 8-11 and 15-17 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 15 and 11 of prior U.S. Patent No. 5,857,464. This is a double patenting rejection.

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,052,612, claims 1-15 of U.S. Patent No. 5,857,464 as well as claims 1-8 of U.S. Patent No. 6,701,180 .

Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are merely broader claims than those of the '612, '464 and '180 patents, eliminating the patentable features of those claims.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deanna K. Hall whose telephone number is 571-272-2819. The examiner can normally be reached on M-F 8:00am-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on 571-272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Deanna K. Hall  
Examiner  
AU 3767

dkh



LOAN H. THANH  
PRIMARY EXAMINER